

**U.S. Pat. Appl. Ser. No. 09/944,745
Attorney Docket No. 10191/1908
Reply to Office Action of April 21, 2004**

REMARKS

Claims 1-10 are pending in the present application. No new matter has been added. Reconsideration is respectfully requested.

With respect to paragraph two (2) of the Office Action, Applicants thank the Examiner for acknowledging the claim for foreign priority and the receipt of the certified copies of the priority documents.

With respect to paragraph three (3), the drawings were objected to as to certain labels. In Figure 3, the word "N" has been amended to --No-- and word "J" has been amended to --YES--. Also, the word "ENDE" has been amended to --END--. No new matter has been added. Approval and entry are respectfully requested. Also, it is noted that the label "OFF_{vorl}" represents a "value of the change over time set as a provisional offset value", so that the term is appropriate since it is clearly explained in the Specification. No new matter has been added. Withdrawal of the objection is therefore respectfully requested.

With respect to paragraph nine (9), claims 1 to 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,914,830 ("Kadlec") in view of U.S. Patent No. 5,854,989 ("Speck").

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 1, 9, and 10 include the feature of driving a hyteresis-exhibiting final controlling element by a drive signal having a variable drive quantity that is *corrected as a function of a change thereof over time*.

The Office Action contends that while "Kadlec does not explicitly teach

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correcting the variable drive quantity as a function of a change thereof over time', "Speck teaches a method of driving a hysteresis-exhibiting final controlling element" ... "which corrects the variable drive quantity as a function of a change of velocity thereof over time". (Office Action, pages 3 to 4).

In contrast, the "Speck" reference concerns "a method and an apparatus for maintaining a vehicle at a specified velocity wherein an adjusting element influences the drive system independently of the driver's command." (Col. 1, lines 7 to 10). Furthermore, the "Speck" references states that "it is possible to use adjusting elements with dead travel or hysteresis between actuation and effect, especially pneumatic elements." (Col. 2, lines 37 to 40). Also, the "Speck" references states that "the actual acceleration of the vehicle is calculated in element 42 from the measured values of the vehicle velocity" and that "[t]his can be done either by means of differentiation with respect to time or by calculating the difference between two vehicle velocity values detected on a fixed time grid." (Col. 4, lines 33 to 38).

Accordingly, the "Speck" reference does not identically disclose (or even suggest) the feature of driving a hyteresis-exhibiting final controlling element by a drive signal having a variable drive quantity that is corrected as a function of a change thereof over time. The "Beck" reference merely indicates that a vehicle is maintained at a specified velocity such that an adjusting element influences the drive system independently of the driver's command and that the actual acceleration of the vehicle is calculated from the measured values of the vehicle velocity via differentiation with respect to time or calculating the difference between two vehicle velocity values detected on a fixed time grid. In the "Speck" reference, a variable drive quantity (actual acceleration) is simply calculated. Nothing in the "Speck" reference identically discloses (or suggests) the feature of driving a hyteresis-exhibiting final controlling element by a drive signal having a variable drive quantity that is corrected as a function of a change thereof over time, as provided for in the context of claims 1, 9, and 10.

Furthermore, the Office Action conclusorily asserts that "it would have been obvious to one of ordinary skill in the art to modify Kadlec, in view of Speck, to correct the variable as a function of a change thereof over time." (Office Action, pages 4).

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the references do not properly support a

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§ 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of In re Kotzab has made plain

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that even if a claim concerns a “technologically simple concept” -- which is not the case here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Here again, there have been no such findings to establish that the features discussed above of the rejected claims are met by the reference relied upon. As referred to above, any review of the reference, whether taken alone or combined, makes plain that the reference simply does not describe the features discussed above of the rejected claims.

It is therefore respectfully submitted that claims 1, 9, and 10 are allowable for these reasons.

Claims 2 to 8 depend on claim 1, and are therefore allowable at least for the same reasons as claim 1.

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Conclusion

In view of all of the above, it is believed that the objections and the rejections have been obviated, and that claims 1 to 10 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,

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